

REMARKS

Claims 9, 11-12, and 14-23 have been amended, claim 10 has been canceled, and new claims 24-35 have been introduced. The entire specification has been amended to remove "addition" from its modifier position in the polymer description. This word was inadvertently inserted during translation, and does not appear in the originally filed PCT document. As the examiner has noted, the originally filed claim 9 was directed to a "polymer," one not modified by the word "addition." This claim language, as well as the originally filed PCT application, gives adequate support for the specification amendment, and no new matter is introduced thereby.

CLAIM OBJECTIONS

Chemical structures have been redrawn as requested by the examiner, and unnecessary hyphens have been removed.

The formula depicted on page 26 of the specification is the preferred embodiment set forward in claim 11, and should not be introduced into claim 9.

The designation of R^4 has been placed into the alternative.

The $-(CO)_c-R^6$ structure is an alternate definition of R^4 , as has been made more clear.

Applicants have introduced the word "optionally," and replaced "O" with "0" where suggested by the examiner.

The definition of R^1 in claim 9 has been further clarified, as has the Markush

language in that claim.

Claim 9 has been amended to give antecedent basis for C₂-C₄ alkyl in the definition of R⁴ in claims 12 and 16.

The word “addition” has been removed from claims 15 and 16.

REJECTIONS UNDER 35 USC §112, ¶2

In claims 9, 15-16, and 23, the word “obtainable” has been replaced with “obtained.” In claims 9, 12, 16, and 23, the phrase “may be” has been replaced with “are independently.”

The narrow range for n has been removed in each of claims 12, 16, and 23, and introduced into newly dependent claims 32-34.

Support for the varied use of (a1) and (a2) in the claims has been introduced into the specification. No new matter is introduced thereby, as the claims are considered to be part of the specification as originally filed.

REJECTION UNDER 35 USC §101/§112, ¶2

Claims 17-22 have been amended from the “use” format.

REJECTION UNDER 35 USC §102(B)

The examiner asserts that claims 9, 13-16, 18, 20, and 22-23 are anticipated under 35 USC §102(b) by the disclosure of Blankenburg et al. (WO 99/04750), as

evidenced, in part, by Tropsch et al. (US 5,869,032) and Sramek (US 4,871,529).

Claim 9 has been amended appropriately, and applicants respectfully submit that the claims are no longer anticipated by this reference.

REJECTIONS UNDER 35 USC §103(A)

The examiner further asserts that claims 9, 13-16, 18, 20, and 22-23 are obvious under 35 USC §103(a) over the disclosure of Blankenburg et al., in view of Sramek, Kim et al. (US 6,277,386), or Habeck et al. (US 6,037,487). Applicants respectfully traverse these rejections.

Neither the Kim et al. nor the Habeck et al. references are available for use in an obviousness rejection under 35 USC §103. As set forward in §103(c), subject matter which is prior art solely under subsections §102(e), (f), or (g) does not preclude patentability under §103 where it and the claimed invention were commonly owned or subject to an obligation of assignment to the same person.

Given the present application priority date of August 26, 1999, the Kim and Habeck references are only available as prior art under §102(e). Further, as the subject matter of Habeck, Kim, and the present invention were all subject to an obligation of assignment to BASF AG at the time of their invention, §103(c) is applicable. Accordingly, these references cannot preclude patentability under §103(a).

Applicants further submit that the present claims are not obvious over the combined disclosures of Blankenburg et al. and Sramek, as one of skill in the art would

view Sramek to teach away from a combination of the relevant inventions. A key difference between the composition of Sramek and that of Blankenburg lies in the film-forming characteristics obtained thereby. In Sramek, the specific composition causes the hairspray resin to contract as it dries, imparting better holding properties. In contrast, the composition disclosed in Blankenburg forms a uniform film upon drying. The compositions are in the same field of endeavor, and yet they achieve different aims.

Sramek specifically states that inclusion of silicone compounds in addition to those indicated “can have detrimental effects on the hold properties of the hairspray resin” (col.9:10-12). Introducing the hairspray resins from Sramek into a composition having additional silicone substituents, such as in Blankenburg, would defeat the intended purpose of the cited reference. Further, removing the specified silicone compounds from the Sramek composition would also defeat the purpose of that invention. Accordingly, one of skill in the art would not be likely to combine the cited disclosures.

In addition, as is indicated in the specification, the claimed compositions have been found to be superior to prior art preparations in their skin care and hair care properties, and have unexpectedly good film-forming and setting properties (see p.10:17-23). As is further indicated in the specification, the claimed UV light protection compositions have been found to demonstrate unexpectedly improvements in the stability of the compositions, stability of the UV filters themselves, and high UV light

protection using low concentrations of UV light filters (see p.12:19-45). These unexpected properties arise, at least in part, from the unexpectedly superior adhesion of the formulations to the skin and hair.


In light of these benefits, and further in light of Sramek's teaching away, applicants respectfully submit that the present claims are not, in fact, obvious over the combined disclosures of that reference and that of Blankenburg. Accordingly, as the present claims are not obvious under §103(a), applicants respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, applicants consider that the rejections of record have been obviated and respectfully solicit passage of the application to issue.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
KEIL & WEINKAUF



David C. Liechty
Reg. No. 48,692

1350 Connecticut Ave., N.W.
Washington, D.C. 20036
(202)659-0100
DCL/kas